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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,925	01/18/2001	Elena Leonidovna Fokina		8866

7590 05/06/2004
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EXAMINER

JENKINS, DANIEL J

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,925

Applicant(s)

FOKINA ET AL.

Examiner

Daniel J. Jenkins

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1742

1. The Examiner has carefully considered Applicant's Response of 3/7/03. As a preliminary matter, the Examiner has considered the Response of 3/7/03, although the 3 month period for response for the Action of 11/21/02 was timely due by 2/21/02. The Response date entered as the date of arrival at the USPTO. Applicant must provide for a month extension for the late response as per MPEP rules. Additionally, Applicant has not followed USPTO rules for submission of an amendment, including for instance the underlining of new language and the lining through of deleted language. These rules must be complied with in following responses.

2. As to the merits of the Response, the Examiner does not find the amendment and argument persuasive. In particular, Applicant has amended the claims to include limitations that were not present in the disclosure as originally filed. In particular, the accelerations during milling is not initially disclosed and constitute new matter.

Applicant argues the quality of the coating in his first paragraph of response. This limitation is not present in the pending claims.

Applicant argues the accelerations in his second paragraph of response. This limitation constitutes new matter.

Applicant argues the heating temperature in his third paragraph of response. Initially, the Examiner notes that this limitation is only present in claims 3 and 7. Secondly, this temperature is used as both a solvent removal and/or reduction temperature. The Examiner notes that Moriguchi et al. teaches drying the wet milled powder, this limitation being further addressed in the body of the current rejection.

Art Unit: 1742

The Examiner recommends that Applicant amend the claims to more clearly show the two distinct embodiments of his invention, where a metal powder is applied, and where a metal precursor powder is applied.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1742

6. Claims 1-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. '064 in view of Farkas

Lee et al. disclose the invention substantially as claimed.

Lee et al. disclose a method of coating a hard powder comprising:

providing a hard powder (col. 1, lines 25-26);

adding a metal powder compound including sulfides (col. 2, lines 41-54) to form a mixture (col. 1, lines 30-31);

mechanically mixing the mixture to coat the hard powder with the metal compound (col. 1, lines 36-42); and

heating the coated hard powder in a non-oxidizing atmosphere to reduce the metal compound to a metal (col. 1, lines 43-48).

However, Lee et al. do not disclose the initial degreasing and cleaning of the hard powder prior to coating.

Lee et al. further disclose wherein the heating temperature is selected based on the selection of initial starting materials (col. 4, lines 39-40), making it obvious to one of ordinary skill in the art to determine through routine experimentation reduction temperature ranges.

Farkas teaches to degrease and clean the surface of hard powders (see EXAMPLE 1) prior to coating in the same field of endeavor for the purpose of improving the bond between the coating material and the particle to be coated.

It would have been obvious to use degreasing and cleaning as taught by Farkas in the invention of Lee et al. in order to improve the bond of the coating material.

Art Unit: 1742

In claim 9, the Examiner finds that the term substrate encompasses particles.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebata et al. in view of Farkas.

Ebata et al. disclose the invention substantially as claimed. Ebata et al. disclose a method of applying a metal layer to a substrate comprising:

applying a metal compound comprising a metal oxide to a substrate (col. 2, lines 38-48); and

heating the applied metal compound in a reducing atmosphere to form a metal layer upon the substrate (col. 3, lines 18-30).

Farkas teaches to degrease and clean the surface of hard substrates (see EXAMPLE 1) prior to coating in the same field of endeavor for the purpose of improving the bond between the coating material and the substrate to be coated.

It would have been obvious to use degreasing and cleaning as taught by Farkas in the invention of Lee et al. in order to improve the bond of the coating material.

In claim 9, the Examiner finds that the term substrate encompasses particles.

Ebata et al. is silent as to if the paste is rolled after applying.

It is common knowledge in the prior art to roll applied coating materials in the same field of endeavor for the purpose of improving evenness of the application.

It would have been obvious to one having ordinary skill in the art at the time of the invention to roll the applied paste of Ebata et al. in order to improve the evenness of the applied coating.

Art Unit: 1742

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.


9. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure of the acceleration limitation in the Application as originally filed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Jenkins whose telephone number is 571-272-1242. The examiner can normally be reached on M-TH6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1242. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel J. Jenkins
Primary Examiner
Art Unit 1742

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